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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,716	07/18/2000	Kyoji Saito	P19789	9554
7055	7590	01/14/2005	EXAMINER PHAN, TAM T	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			ART UNIT 2144	PAPER NUMBER

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,716

Applicant(s)

SAITO, KYOJI

Examiner

Tam (Jenny) Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 13-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 18 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/13/2004 has been entered.
2. Claims 1-12 are cancelled. Claims 13-16, 20, 23, 27, 30, 32, and 35 are currently amended. Claims 17-19, 21-22, 24-26, 28-29, 31, 33-34, and 36 are previously presented. Claims 13-36 are presented for examination.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-d, which papers have been placed of record in the file.
4. The effective filing date for the subject matter defined in the pending claims which has support in parent JP 11-321411 in this application is 11/11/1999. Any new subject matter defined in the claims not previously disclosed in parent JP 11-321411, is entitled to the effective filing date of 07/18/2000.
5. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Objections

6. Claim 26 is objected to because of the following informalities: "form" in line 2 of claim 26 should read "from". Appropriate correction is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 13-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, of U.S. Patent No. 6,618,749. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the two pending applications are minor wording, which do not change the scope of the invention. Refer to the below observation for obvious variations of limitation in claims 13-36 of the instant application and claims 1-9 of the pending application.

Instant Application 09/618,716	U.S. Patent Number 6,618,749
<p>13. An image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via a computer network; and a controller configured to convert the attached data into image data; the controller further being configured to judge whether or not the received e-mail is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus, based on whether or not a header of the received e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail.</p> <p>14. The image receiving apparatus according to claim 13, further comprising a printer configured to print the image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data.</p> <p>15. The image receiving apparatus according to claim 13, further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts a predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted image data.</p> <p>16. An image receiving apparatus receiving an e-mail, the e-mail including a header and a body, the body including a message, the message including an image</p>	<p>1. An Internet transmission apparatus connected to a computer network, comprising: a transmitter that transmits a message in e-mail format to a designated destination via the computer network; a receiver that receives e-mail data transmitted via the computer network; a determiner that determines whether or not the received e-mail data is an error message indicating that the e-mail data transmitted from said transmitter has not been successfully transmitted;</p> <p>an extractor that, when said determiner determines that the received e-mail is the error message, extracts a specific data from the received e-mail data, the specific data containing at least information regarding an error and a predetermined portion of the transmitted message from said transmitter; an editor that edits the extracted specific data so that the specific data fits on one page of recording paper having a predetermined size, the editor not changing a resolution of the specific data;</p> <p>and a printer that prints the edited specific data on one page of recording paper having the predetermined size, said editor being configured to edit the specific data when the transmitted message and at least the information regarding an error cannot fit on the one page of recording paper such that another portion of the transmitted message is not printed.</p> <p>2. The apparatus according to claim 1, further comprising: a memory that stores the transmitted message wherein said determiner determines the error message by comparing the received e-mail data with the transmitted message in said memory.</p>

data part, the image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via a computer network; and a controller configured to convert the attached data to image data; and the controller further being configured to search for a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure, and to judge that the received e-mail is an error mail the error mail being related to an e-mail transmitted by the image receiving apparatus when the predetermined image data fixed code is detected.

17. The image receiving apparatus according to claim 16, wherein the controller searches for the predetermined image data fixed code in the whole received e-mail when the received e-mail is a single-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected.

18. The image receiving apparatus according to claim 17, further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data.

19. The image receiving apparatus according to claim 17, configured to print image data, wherein the claim 17 further comprising a printer controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited

3. An Internet facsimile apparatus connected to a computer network, comprising: a scanner that scans an original to obtain image data; a transmitter that transmits image data in e-mail format to a designated destination via the computer network; a receiver that receives e-mail data transmitted via the computer network; a determiner that determines whether or not the received e-mail data is an error message indicating that the image data in e-mail format transmitted from said transmitter has not been successfully transmitted; and an extractor that, when said determiner determines the received e-mail data is the error message, extracts a specific data from the received e-mail data, the specific data containing at least information regarding an error and a predetermined portion of the image data obtained from the original by the scanner; a converter that converts the extracted specific data into facsimile data; an editor that edits the converted facsimile data so that the facsimile data fits on one page of recording paper having a predetermined size, the editor not changing a resolution of the specific data and a printer that prints the edited specific data on one page of recording paper having the predetermined size, said editor being configured to edit the specific data when the image data and at least the information regarding an error cannot fit on the one page of recording paper such that another portion of the image data is not printed.

information into image data, and the printer prints the converted predetermined image data.

20. An image receiving method comprising: receiving an e-mail with data attached, via a computer network; converting the attached data into image data; and judging whether or not the received e-mail is an error mail, the error mail being related to an e-mail transmitted by a receiving apparatus of the error mail based on whether or not a header of the e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail.

21. The image receiving method according to claim 20, further comprising abstracting predetermined information from the e-mail when an error mail is detected; converting the abstracted predetermined information into image data; and printing the converted image data.

22. The image receiving method according to claim 20, further comprising abstracting predetermined information from the e-mail when an error mail is detected; editing the abstracted predetermined information; converting the edited predetermined information into image data; and printing the converted image data.

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5. A method for receiving image data in e-mail format via a computer network, comprising: transmitting a message in e-mail format to a designated destination via the computer network; receiving e-mail data transmitted via the computer network; determining whether or not the received e-mail data is an error message indicating that the e-mail data has not been successfully transmitted; extracting, when the determining determines that the received e-mail is the error message, a specific data from the received e-mail data, the specific data containing at least information regarding an error and a predetermined portion of the transmitted message; editing the extracted specific data so that the specific data fits on one page having a predetermined size, the editing not changing a resolution of the specific data and printing the edited specific data on one page having the predetermined size, the specific data being edited, when the transmitted message and at least the information regarding an error cannot fit on the one page of recording paper, such that another portion of the transmitted message is not printed.

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Claim Rejections - 35 USC § 112

9. Claims 13-36 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: "the error mail being related to an e-mail transmitted by the image receiving apparatus". There was no step in the claimed limitation to indicate that the image receiving apparatus transmit an e-mail prior to receiving an error mail that is related to the transmitted e-mail.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 13-15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyota et al. (U.S. Patent Number 5,812,278), hereinafter referred to as Toyota in view of RFC2305 (RFC2305 – "A Simple Mode of Facsimile Using Internet MAIL" March 1998).

12. Regarding claim 13, Toyota disclosed an image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via a computer network (column 3 lines 20-23); and a controller configured to convert the attached data into image data; the controller further being configured to judge whether or not the received e-mail is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus based on whether or not a header of the received e-mail includes a

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predetermined character string (column 6 lines 38-46, lines 57-61, column 7 lines 52-63).

13. Toyoda taught the invention substantially as claimed. However, Toyoda did not expressly teach the predetermined character string being related to a sender of the error mail.

14. Toyoda suggested exploration of art and/or provided a reason to modify the image apparatus with the predetermined character string being related to a sender of the error mail (column 6 lines 57-61, column 7 lines 52-63).

15. RFC 2305 disclosed teachings of judging the received e-mail based on whether or not a header of the e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail (Sections 2.2.1, 5.1, 5.2.1, 5.2.2).

16. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the image receiving apparatus of Toyoda with the teachings of RFC2305 to include the sender judging feature in order to maintain interoperability with Internet mail (Section 5.1) since any security to be provided should be part of the Internet security infrastructure (Section 5.1). In addition, parsing the sender to determine the mail status would also help save resources since unnecessary processing or error or failure mails consume resources and therefore undesirable (Section 5.2.2 paragraphs 1-2).

17. Regarding claim 14, the Toyoda disclosed an image receiving apparatus further comprising a printer configured to print the image data, wherein the controller, when an

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error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (column 1 lines 43-61, column 19 lines 24-50, column 20 lines 3-52).

18. Regarding claim 15, the Toyoda disclosed an image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted image data (column 1 lines 43-61, column 19 lines 24-50, lines 57-61, column 20 lines 3-52).

19. Regarding claim 20-22, the method corresponds directly to the image receiving apparatus of claims 13-15, and thus these claims are rejected using the same rationale.

20. Since all the limitations of the claimed invention were disclosed by the combination of Toyoda and RFC2305, claims 13-15 and 20-22 are rejected.

21. Claims 16-19, 23-26, 27, 30, 32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyota et al. (U.S. Patent Number 5,812,278), hereinafter referred to as Toyota in view of Wakasugi et al. (U.S. Patent Number 6,823,367), hereinafter referred to as Wakasugi.

22. Regarding claim 16, Toyoda disclosed an image receiving apparatus receiving an e-mail, the e-mail including a header and a body, the body including a message, the message including an image data part (Figures 6-7), the image receiving apparatus

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comprising: a receiver configured to receive an e-mail with data attached, via a computer network (column 3 lines 20-23); and a controller configured to convert the attached data to image data (column 1 lines 42-61); and the controller further being configured to search for a predetermined information, and to judge that the received e-mail is an error mail the error mail being related to an e-mail transmitted by the image receiving apparatus, the error mail being related to an e-mail transmitted by the image receiving apparatus, when the predetermined information is detected (column 6 lines 38-46, lines 57-61, column 7 lines 52-63).

23. Toyoda taught the invention substantially as claimed. However, Toyoda did not expressly teach searching for a predetermined image data fixed code in the image data part of the e-mail [body of the email] and to judge that the received e-mail is an error mail when the predetermined image data fixed code is detected.

24. Toyoda suggested exploration of art and/or provided a reason to modify the image receiving apparatus with the searching of signature code in a multi-part mail structure (Figure 7, column 13 lines 20-25, column 29 lines 5-11).

25. Wakasugi disclosed a controller for searching a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure, and to judge that the received e-mail is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected (Figures 4-5, column 2 lines 17-22, column 8 lines 2-8, column 12 lines 11-18).

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26. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined apparatus of Toyoda with the teachings of Wakasugi to include the searching of image data fixed code in a multi-part mail structure in order to provide a more efficient method of identify error mail since header information are trivial to fake or unavailable and image data fixed code [i.e. abcde12345] is often present in multi-part mail structure (Figures 4-5).

27. Regarding claim 17, Wakasugi disclosed an image receiving apparatus wherein the controller searches for the predetermined image data fixed code in the whole received e-mail when the received e-mail is a single-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected (column 8 lines 2-8, column 12 lines 11-18).

28. Regarding claim 18, Toyoda disclosed an image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (column 1 lines 43-61, column 19 lines 24-50, column 20 lines 3-52).

29. Regarding claim 19, Toyoda disclosed image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image

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data, and the printer prints the converted predetermined image data (column 1 lines 43-61, column 19 lines 24-50, lines 57-61, column 20 lines 3-52).

30. Regarding claim 23-26, the method corresponds directly to the image receiving apparatus of claims 16-19, and thus these claims are rejected using the same rationale.

31. Regarding claim 27, Toyoda and Wakasugi disclosed an image receiving apparatus connected to a server and receiving an e-mail, when the received e-mail is an error mail, the e-mail including a header and a body, the body including a message, the message including an image data part (Toyoda, Figures 6-7, column 13 lines 20-25), the image receiving apparatus comprising: a receiver configured to receive an e-mail to which data is attached, via the server; a converter configured to convert the attached data into image data (Toyoda, column 1 lines 42-61); a memory configured to store a predetermined image data fixed code, an image data fixed code being contained in the image data part (Toyoda, column 1 lines 42-61, column 7 lines 52-63; Wakasugi, column 12 lines 36-42); and a controller configured to search for a predetermined header fixed message in the header of the received e-mail, to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of the received e-mail, and to judge that the received email is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus, when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory (Toyoda column 6 lines 38-46, lines 57-61, column 7 lines 52-63; Wakasugi Figures 4-5, column 2 lines 17-22, column 8 lines 2-8, column 12 lines 11-18).

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32. Regarding claim 30, Toyoda and Wakasugi combined disclose an image receiving apparatus connected to a server and receiving an e-mail, when the received e-mail is an error mail, the received error mail including a header and a body, the body including a message, the message including an image data part (Toyoda, Figures 6-7, column 13 lines 20-25), the image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via the server; a converter configured to convert the attached data into image data (Toyoda, column 1 lines 42-61); a first memory configured to store at least one predetermined character string (Toyoda, column 1 lines 42-61, column 7 lines 52-63; Wakasugi, column 12 lines 36-42); a second memory configured to store a predetermined image data fixed code, an image data fixed code being contained in the image data part (Toyoda, column 1 lines 42-61, column 7 lines 52-63; Wakasugi, column 12 lines 36-42); and a controller configured to search for character string in a [From:] field of the header of the received e-mail, to compare the character string in the [From:] field of the header with the at least one predetermined character string stored in the first memory, to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the character string in the (From:) field of a header matches the at least one predetermined character string stored in the first memory (Toyoda, column 24 lines 29-41; Wakasugi, column 8 lines 2-8) , and to judge that the received e-mail is an error mail the error mail being related to an e-mail transmitted by the image receiving apparatus when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the second memory (Toyoda column 6 lines 38-46,

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lines 57-61, column 7 lines 52-63; Wakasugi Figures 4-5, column 2 lines 17-22, column 8 lines 2-8, column 12 lines 11-18).

33. Regarding claim 32, the method corresponds directly to the image receiving apparatus of claims 27, and thus is rejected using the same rationale.

34. Regarding claim 35, the method corresponds directly to the image receiving apparatus of claims 30, and thus is rejected using the same rationale.

35. Since all the limitations of the claimed invention were disclosed by the combination of Toyoda and Wakasugi, claims 16-19, 23-26, 27, 30, 32, and 35 are rejected.

36. Claims 28-29, 33-34, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyota et al. (U.S. Patent Number 5,812,278), hereinafter referred to as Toyota, in view of Wakasugi et al. (U.S. Patent Number 6,823,367), hereinafter referred to as Wakasugi and further in view of Iwazaki (U.S. Patent Number 6,687,742).

37. The combination of Toyoda and Wakasugi disclosed an image receiving apparatus with all the limitations listed in claim 27 rejection above.

38. The combination of Toyoda and Wakasugi taught the invention substantially as claimed. However, Toyoda and Wakasugi combined did not expressly teach the predetermined header fixed message comprises [X:mailer:] field.

39. Wakasugi suggested exploration of art and/or provided a reason to modify the image receiving apparatus with other header fields (Figures 4-5, column 8 lines 2-8).

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40. Iwazaki disclosed a predetermined header fixed message comprises [X:mailer:] field (Figure 5, column 6 lines 28-38, column 7 lines 27-50).

41. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined apparatus of Toyoda and Wakasugi to include the [X:mailer:] field in header parsing feature since it would be preferable to includes all identification data needed to determine the status of incoming mail (Wakasugi, column 7 lines 21-47). Most users preferred to implement header parsing based upon additional list categories, such as the "FROM", "TO", "BCC", "CC", and "SUBJECT" email headers as well as other headers (Wakasugi, Figures 8-9, 11-12, 13, column 8 lines 2-8).

42. Regarding claim 29, Iwazaki image receiving apparatus wherein the predetermined image data fixed code comprises SUqk (Figure 9).

43. Regarding claim 33-34, the method corresponds directly to the image receiving apparatus of claims 28-29, and thus is rejected using the same rationale.

44. Regarding claim 31 and 36, the limitation of these claims are similar to the limitation of claim 29, and thus these claims are rejected using the same rationale.

45. Since all the limitations of the claimed invention were disclosed by the combination of Toyoda, Wakasugi, and Iwazaki, claims 28-29, 33-34, 31, and 36 are rejected.

Response to Arguments

46. Applicants' arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection. Referred to above rejections for details.

47. In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). Applicant argued, "Applicant additionally notes that the IWAZAKI document issued as a patent on February 3, 2004 and was filed in the U.S. Patent and Trademark Office on May 31, 2000" and "Applicant notes that the present application is based upon and enjoys the effective filing date of .1P 1 1-32 141 1 which was filed on November 11, 1999, which is before the 35 U.S.C. j 102(e) date of the IWAZAKI reference relied upon by the Examiner. Thus, Applicant submits that the IWAZAKI reference is an inappropriate basis for the rejection of any of the claims in the present application". The Office is aware of the possible claimed foreign priority date (November 11, 1999) regarding the instant application upon receiving a certified English translation of the priory document. However, the IWAZAKI reference was based upon and enjoyed the foreign application JP 11-213897 (July 28, 1999) and JP 11-156481 (June 3, 1999). Therefore the IWAZAKI reference is valid against the claimed limitations as detailed in the above rejections.

48. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

Conclusion

49. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

a. Leeds et al. (U.S. Patent Number 6,393,465) disclosed a method and system for parsing and analyzing incoming electronic mail messages. The system of the present invention can analyze e-mail headers to determine whether or not the e-mail has been received from a site suspected of sending junk e-mail. A received e-mail that conforms to RFC 821 includes fields identifying the sender and the recipient, i.e., the "From:" and the "To:" fields, respectively. Messages may optionally contain a "Reply-To:" field if a user wishes to have his/her replies directed to a different e-mail address.

b. Praitis et al. (U.S. Patent Number 6,594,697) titled "Client system having error page analysis and replacement capabilities" disclosed a browser that requests electronic documents from a server computer over a computer network and displays friendly error messages or pages when an error is detected. The browser analyzes a response returned to the client computer from the server computer to determine whether an error occurred using information in the header of the response. If decision operation determines that an error occurred, then the browser operation analyzes the body of the response to determine whether the response body is a friendly response.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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